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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,905	07/31/2003	John J. Donahue	011684.00014	9609

22907 7590 03/30/2009

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ART UNIT	**PAPER NUMBER**
2176	

MAIL DATE	DELIVERY MODE
03/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/630,905	DONAHUE, JOHN J.	
	Examiner	Art Unit	
	RACHNA S. DESAI	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38,40 and 41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38 and 40-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendments and Remarks filed on 01/07/09.

2. Claims 1-41 are pending. Claims 1, 20, 27, 31, and 33 are independent claims. Claim 39 has been cancelled.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-19, 31-33, 36-38, and 40-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Specifically with respect to independent claim 1, in light of Supreme Court precedent and recent Federal Circuit decisions, a 101 process must be (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as article or materials) to a different state or thing. When neither of these requirements are met by the claim, the method is not a patent eligible process under 101 and is directed to non-statutory subject matter. It is noted the preamble "a computer-assisted method" does not tie the method to the computer and the steps must be tied to a computer.

Dependent claims 2-29, 38, and 40-41 fail to further define the recited method as statutory subject matter.

Independent claim 31 and claim 32 are considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus. Where there is no evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Regarding independent claim 33 and dependent claims 36-37, the system for deconstructing a contract document into a workflow process comprising an editing tool, document generator, and transaction engine is considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus. Where there is no evidence in the specification that the components of the system may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-19, 38, and 40-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claim 1 has been amended to recite, *querying the user to identify at least one corresponding user-selected workflow process parameter*. The Specification only appears to support receiving user input to identify a parameter, but not "querying". Clarification is required.

Claims 2-19, 38, and 40-41 are rejected under 35 USC 112, first paragraph for fully incorporating the deficiencies of their base claim from which they depend.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 31-32 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim element "means for detecting" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Specifically, it is not clear what structure, material, or acts perform the detection.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claims 32 and 36 are rejected under 35 USC 112, second paragraph for fully incorporating the deficiencies of their base claim from which they depend.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-3, 5-6, 10-18, 20-28, 31, 33-38 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Prior Art disclosed in Zhou et al., US 2003/0018481 A1, 01/23/03 (filed 03/15/01) in view of Wilce et al., US 2003/0023527 A1, 01/30/03 (filed 08/14/01) and Teng, US 2002/0152254 A1, 10/17/02 (filed 11/30/01, provisional filed on 12/22/00).

Regarding claim 1, the prior art disclosure in Zhou teaches ***detecting user-selected text portions of a displayed contract document*** in a product called

ContractMaker. See page 1, paragraph [0004]-[0005]. The prior art disclosure in Zhou teaches analyzing the text portion to identify a parameters for assembling a portion of a contract such as the parties involved in the contract which meets the portion of the limitation, ***identify at least one corresponding user-selected workflow process parameter***. See page 1, paragraph [0004]-[0005].

The prior art of Zhou does not teach *querying the user to identify at least one corresponding user-selected workflow process parameter, tagging the document based on the plurality of distinct user-selected text portions and corresponding user-selected workflow process parameters, wherein said tagging correlates each user-selected text portion to a user-selected order within a computer-based contract negotiation workflow process; storing each user-selectable text portion with corresponding user-selectable workflow parameters into a data structure representing an ordering of information to be elicited when the workflow process executes* or *executing a computer-based contract negotiation workflow process using the data structure as a template to drive the workflow process.*

Wilce teaches a method for facilitating agreement generation and negotiation via an agreement modeling system. Wilce teaches the agreement document that may be supplied by a user via a client device and transmitting the information to the agreement modeling system controller which stores and interprets the information into an XML data format which meets the limitation, ***storing each text portion with corresponding workflow process parameters into a data structure***. See page 6, paragraph [0086].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Wilce's storing of user-supplied information into an XML data format in the prior art disclosure of Zhou because providing the information in an XML format provides for flexibility in that the system can model dynamic information and facilitate communication of dynamic agreement information between client and server in a technology neutral manner. See page 6, paragraphs [0086]-[0087] of Wilce.

Wilce teaches the XML data format storing the information is used to facilitate generation and negotiation of an agreement/contract document; however, Wilce does not expressly state the data structure represents an ordering of information to be elicited when the workflow is executed or using the data structure as a template to drive the workflow process. Wilce also does not teach querying a user to identify the workflow process parameter and tagging the document.

Teng teaches creating a template where workflow objects, types, and actions are added by a user which meets the limitation, ***querying the user to identify at least one corresponding user-selected workflow process parameter.*** See column 15, paragraphs [0187]-[0192] and figures 16-24.

Teng discloses the template file can be an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***tagging the document based on the plurality of distinct user-selected text portions and corresponding user-selected workflow process parameters, wherein said tagging correlates each user-selected text protion to a user-selected order within a computer-based contract***

negotiation workflow process. See page 1, paragraph [0014], page 14, paragraph [0184], and page 42. See also page 15, page 18, paragraphs [0220]-[0221]. *Examiner note: in creating an XML template file defining the workflow, the user is tagging a document.*

Teng discloses accessing an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***a data structure representing an ordering of information to be elicited when the workflow process is executed; and executing a workflow process using the data structure as a template to drive the workflow process.*** See page 1, paragraph [0014], page 14, paragraph [0184], and page 42.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 2, Zhou does not expressly teach the workflow attributes and parameters define the workflow process steps. Teng teaches the workflow attributes and parameters defined in the template define the steps of a workflow process. The template is an XML document that defines a set of parameters for each of the actions available to that particular workflow type. See page 14, paragraph [0184] and page 15. Actions of the workflow are executed in the order they appear. This meets the limitation, ***the user-selected workflow process parameters comprise an ordered phase of the workflow process, wherein the ordered phase determines a first grouping of information that will be elicited when the workflow process is executed.***

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 3, Zhou does not teach the parameters defined in the template define a workflow process. Teng teaches the workflow attributes and parameters defined in the template define the steps of a workflow process. The template is an XML document that defines a set of parameters for each of the actions available to that particular workflow type. See page 14, paragraph [0184] and page 15. Actions of the workflow are executed in the order they appear. This meets the limitation, ***the user-selected workflow process parameters comprise a step within the ordered phase of the workflow process, wherein the step determines the order within the phase in which corresponding information will be elicited when the workflow process is executed.***

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 5, the prior art of Zhou teaches displaying the process parameters to a use in a word processor where a user can edit those parameters which meets the limitation, ***displaying transaction negotiation process parameters***. See page 1, paragraphs [0004]-[0005].

Regarding claim 6, Zhou does not teach detecting a user-selected modification of a label used to designate a phase. Teng discloses a user can select the identification or unique name to identify a workflow. See page 15, paragraph [0189]. Further, Teng teaches each phase has a name. See page 17, paragraph [0211]. This indication of the name of a step in the workflow meets the limitation, ***detecting a user-selected modification of a label used to designate a phase***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 10, Zhou/Wilces do not teach the workflow parameters comprise placeholder indications; however, Teng teaches a user fully defines the workflow process using a template which can include the specification of a placeholder which meets the limitation, ***detecting user-selected specification of a placeholder***. See page 14, paragraph [0184]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 11, the prior art of Zhou teaches the user can modify or edit the contract to changes assumptions about the order of questions which meets the limitation, ***detecting user-selected specification of a re-ordering of a previously specified workflow parameter***. See page 1, paragraphs [0004]-[0005].

Regarding claim 12, the prior art of Zhou teaches the user can modify or edit the contract to changes assumptions about the order of questions which meets the limitation, ***detecting at least one user-selected specification of a phase, a step within the phase, and a question within the step***. See page 1, paragraphs [0004]-[0005].

Regarding claim 13, The prior art of Zhou does not teach converting each user-selectable text portion with corresponding user-selectable workflow parameters into an XML document; however, Wilce teaches a method for facilitating agreement generation and negotiation via an agreement modeling system. Wilce teaches the agreement document that may be supplied by a user via a client device and transmitting the information to the agreement modeling system controller which stores and interprets the information into an XML data format which meets the limitation, ***converting the user-selectable text portions and process parameters into an XML document.*** See page 6, paragraph [0086].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Wilce's storing of user-supplied information into an XML data format in the prior art disclosure of Zhou because providing the information in an XML format provides for flexibility in that the system can model dynamic information and facilitate communication of dynamic agreement information between client and server in a technology neutral manner. See page 6, paragraphs [0086]-[0087] of Wilce.

Regarding claim 14, Teng teaches generating a GUI from the template from which the workflow process and subflows are executed which meets the limitation, ***generating computer displays containing one or more workflow process parameters***. See pages 14-15. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 15, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract. See page 1, paragraphs [0004]-[0005]. This meets the limitation, ***generating computer displays that are arranged into phases containing steps, wherein the steps comprise one or more questions.***

Regarding claim 16, the prior art of Zhou teaches generating a contract document based on answers to questions which meets the limitation, ***generating a new document containing information elicited in step 5***. See page 1, paragraph [0004]-[0005].

Regarding claim 17, the prior art of Zhou allows a user to edit the contract parameters which meets the limitation, ***permitting a user to modify the workflow process parameters***. See page 1, paragraph [0004]-[0005].

Regarding claim 18, the prior art of Zhou teaches ***detecting a question*** and the text to be associated with that question. See page 1, paragraph [0004]-[0005].

Regarding claim 20, the prior art disclosure in Zhou teaches ***reverse engineering a contract text document into a data structure representing a workflow process*** in a product called ContractMaker. See page 1, paragraph [0004]-[0005]. The prior art disclosure in Zhou displaying a contract document on an interface and receiving user input from the user interface which meets the limitation, ***displaying the contract text document on a computer screen; receiving user input from editing tools superimposed over the contract text document***. See page 1, paragraph [0004]-[0005].

The prior art of Zhou does not teach *wherein the editing tools permit the user to tag the document with associated workflow process parameters based on user selected portions of the document* or *generating and storing a data structure*.

However, Wilce teaches a method for facilitating agreement generation and negotiation via an agreement modeling system. Wilce teaches the agreement document that may be supplied by a user via a client device and transmitting the information to the agreement modeling system controller which stores and interprets the information into an XML data format which meets the limitation, ***generating and storing the data structure***. See page 6, paragraph [0086].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Wilce's storing of user-supplied information into an XML data format in the prior art disclosure of Zhou because providing the information in an XML format provides for flexibility in that the system can model dynamic information and facilitate communication of dynamic agreement information between client and server in a technology neutral manner. See page 6, paragraphs [0086]-[0087] of Wilce.

Wilce teaches the XML data format storing the information is used to facilitate generation and negotiation of an agreement/contract document; however, Wilce does not expressly state the data structure represents is a template for driving the workflow process from the tagged document.

Teng discloses the template file can be an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***permit the user to tag the document with***

associated workflow process parameters based on user selected portions of the document, wherein said tagging correlates each user-selected portion to a user-selected order within the workflow process. See page 1, paragraph [0014], page 14, paragraph [0184], and page 42. See also page 15, page 18, paragraphs [0220]-[0221]. *Examiner note: in creating an XML template file defining the workflow, the user is tagging a document. Further, regarding wherein clauses, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure.*

Teng discloses accessing an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***a data structure as a template for driving the workflow process from the tagged document.*** See page 1, paragraph [0014], page 14, paragraph [0184], and page 42.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate**

a workflow as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 21, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract which meets the limitation, ***a user-specified question that will be asked during execution of the workflow process***. See page 1, paragraphs [0004]-[0005].

Regarding claim 22, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract which meets the limitation, ***the workflow process parameters comprise a user-specified order of a question that will be asked during execution of the workflow process***. See page 1, paragraphs [0004]-[0005].

Regarding claim 23, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process steps creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract which meets the limitation,

the workflow process parameters comprise a question, phase, a step. See page 1, paragraphs [0004]-[0005].

Regarding claim 24, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process steps creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract which meets the limitation, ***user-specified phase indicates a phase during the workflow execution process during which the user-selected portions of the document will be solicited.*** See page 1, paragraphs [0004]-[0005].

Regarding claim 25, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process steps creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract which meets the limitation, ***user-specified step indicates a step during the workflow execution process during which the user-selected portions of the document will be solicited***. See page 1, paragraphs [0004]-[0005].

Regarding claim 26, the prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the

questions that are asked during the creation of a contract which meets the limitation, ***user-specified question comprises a question to be solicited during the workflow execution process to elicit information corresponding to one of the user-selected portions of the document***. See page 1, paragraphs [0004]-[0005].

Regarding claim 27, the prior art disclosure in Zhou teaches ***displaying the contract document on a computer screen; detecting user-selected text portions of the text document on the computer screen*** in a product called ContractMaker. See page 1, paragraph [0004]-[0005]. The prior art disclosure in Zhou teaches analyzing the text portion to identify a parameters for assembling a portion of a contract such as the parties involved in the contract which meets the limitation, ***detecting user-selected options for associating each user-selected text portion with a plurality of workflow process parameters.*** See page 1, paragraph [0004]-[0005].

The prior art of Zhou does not expressly teach the workflow process parameers include an indication of when information corresponding to the user-selected text portion will be solicited during the workflow process and how information corresponding to the text portion will be solicited. However, Wilce teaches a method for facilitating agreement generation and negotiation via an agreement modeling system. Wilce teaches the agreement document that may be supplied by a user via a client device and transmitting the information to the agreement modeling system controller which stores and interprets the information into an XML data format which meets the limitation, ***including at least an indication of when information corresponding to the user-***

selected text portion will be solicited during the workflow process and an indication of how information corresponding to the user-selected text portion will be solicited during the workflow process. See page 6, paragraph [0086].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Wilce's storing of user-supplied information into an XML data format in the prior art disclosure of Zhou because providing the information in an XML format provides for flexibility in that the system can model dynamic information and facilitate communication of dynamic agreement information between client and server in a technology neutral manner. See page 6, paragraphs [0086]-[0087] of Wilce.

Wilce teaches the XML data format storing the information is used to facilitate generation and negotiation of an agreement/contract document; however, Wilce does not *expressly* state the data structure executes the workflow process using a template.

Teng discloses accessing an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***generating a template comprising a data structure that contains portions of the text documents and the associations; based on the data structure, executing a workflow process.*** See page 1, paragraph [0014], page 14, paragraph [0184], and page 42.

The prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract. See page 1, paragraphs [0004]-[0005]. *This meets the*

limitation, ***generating prompts to solicit information based on the template; and in response to detecting responses to the prompts, generating a new contract text document reflecting information entered in response to the prompts.***

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 28, Zhou does not teach generating an XML document containing portions of the text document; however, Teng teaches generating an XML structured document. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral

exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 31, the prior art disclosure in Zhou teaches ***means for detecting user-selected text portions of a displayed contract document*** in a product called ContractMaker. See page 1, paragraph [0004]-[0005]. The prior art disclosure in Zhou teaches analyzing the text portion to identify a parameters for assembling a portion of a contract such as the parties involved in the contract which meets the portion of the limitation, ***means for detecting at least one user-selected workflow process parameter associated with each user-selected text portion of the document***. See page 1, paragraph [0004]-[0005].

The prior art of Zhou does not teach *means for tagging the document to correlate each user-selected text portion with a user-selected order within the workflow process; converting the tagged document into a template comprising a data structure representing an ordering of information to be elicited when the workflow process is executed; and means for using the template to drive the workflow process.*

Wilce teaches a method for facilitating agreement generation and negotiation via an agreement modeling system. Wilce teaches the agreement document that may be

supplied by a user via a client device and transmitting the information to the agreement modeling system controller which stores and interprets the information into an XML data format which meets the limitation, *converting the document into a template comprising a data structure.* See page 6, paragraph [0086].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Wilce's conversion of user-supplied information into an XML data format in the prior art disclosure of Zhou because providing the information in an XML format provides for flexibility in that the system can model dynamic information and facilitate communication of dynamic agreement information between client and server in a technology neutral manner. See page 6, paragraphs [0086]-[0087] of Wilce.

Wilce teaches the XML data format storing the information is used to facilitate generation and negotiation of an agreement/contract document; however, Wilce does not expressly state the *means for tagging the document to correlate each user-selected text portion with a user-selected order within the workflow process*; *a template comprising a data structure representing an ordering of information to be elicited when the workflow process is executed; and means for using the template to drive the workflow process.*

Teng discloses the template file can be an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***means for tagging the document to correlate each user-selected text portion with a user-selected order within the***

workflow process. See page 1, paragraph [0014], page 14, paragraph [0184], and page 42. See also page 15, page 18, paragraphs [0220]-[0221]. *Examiner note: in creating an XML template file defining the workflow, the user is tagging a document using a software tool.*

Teng discloses accessing an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***a data structure representing an ordering of information to be elicited when the workflow process is executed; and means for using the template to drive the workflow process.*** See page 1, paragraph [0014], page 14, paragraph [0184], and page 42.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 33, the prior art disclosure in Zhou teaches ***deconstructing a contract document into a workflow process*** product called ContractMaker. See page 1, paragraph [0004]-[0005]. The prior art disclosure in Zhou teaches analyzing the text portion to identify a parameters for assembling a portion of a contract such as the parties involved in the contract which meets the limitation, ***a document editing tool permitting a user to select text portions of the contract document*** and ***associate with teach text portion one or more workflow process parameters.*** See page 1, paragraph [0004]-[0005].

The prior art of Zhou does not expressly teach the workflow process parameters determine a sequence of content of one aspect of the workflow process, tagging the contract document to correlate each user-selected text portion with a user-selected order within the workflow process, converting tagged text portions and parameters into a template comprising a data structure that represents an ordered sequencing of the workflow process, and generating prompts to a user to enter information based on parameters stored in the template.

However, Wilce teaches a method for facilitating agreement generation and negotiation via an agreement modeling system. Wilce teaches the agreement document that may be supplied by a user via a client device and transmitting the information to the agreement modeling system controller which stores and interprets the information into an XML data format which meets the limitation, ***associating one or more workflow process parameters that determine a sequence or content of one aspect of the workflow process***. See page 6, paragraph [0086].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Wilce's storing of user-supplied information into an XML data format in the prior art disclosure of Zhou because providing the information in an XML format provides for flexibility in that the system can model dynamic information and facilitate communication of dynamic agreement information between client and server in a technology neutral manner. See page 6, paragraphs [0086]-[0087] of Wilce.

Wilce teaches the XML data format storing the information is used to facilitate generation and negotiation of an agreement/contract document; however, Wilce does not *expressly* state associating comprises tagging the document to correlate text portions with a user-selected order within a workflow process; converting the tagged text portions and parameters into a template comprising the data structure that represents an ordered sequencing of the workflow process.

Teng discloses the template file can be an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***tagging the contract document to correlate each user-selected text portion with a user-selected order within the workflow process.*** See page 1, paragraph [0014], page 14, paragraph [0184], and page 42. See also page 15, page 18, paragraphs [0220]-[0221]. *Examiner note: in creating an XML template file defining the workflow, the user is tagging a document.*

Teng discloses accessing an XML template that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***a document generator that converts the tagged text portions***

and associated workflow process parameters into a template comprising a data structure that represents an ordered sequencing of the workflow process. See page 1, paragraph [0014], page 14, paragraph [0184], and page 42.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

The prior art of Zhou further discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract. See page 1, paragraphs [0004]-[0005]. *This meets the limitation, a structured transaction engine that* ***generates computer displays that prompt a user to enter information based on one or more workflow process parameters stored in the template.***

Regarding claim 34, the prior art of Zhou and the teachings of Wilce teach a workflow for a transaction negotiation process. See page 1 of Zhou and pages 5-6 of Wilces.

Regarding claim 35, the prior art of Zhou and the teachings of Wilce teach a workflow for a transaction negotiation process. See page 1 of Zhou and pages 5-6 of Wilces.

Regarding claim 36, the prior art of Zhou and the teachings of Wilce teach a workflow for a transaction negotiation process. See page 1 of Zhou and pages 5-6 of Wilces.

Regarding claim 37, the prior art of Zhou and the teachings of Wilce teach a workflow for a transaction negotiation process. See page 1 of Zhou and pages 5-6 of Wilces.

Regarding claim 38, Zhou/Wilces do not teach the workflow parameters comprise placeholder indications; however, Teng teaches a user fully defines the workflow process using a template which can include the specification of a placeholder. See page 14, paragraph [0184]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is

executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 40, Zhou teaches a user select text in a contract document. Zhou does not teach the data structure comprises an XML file and tagging the XML file to include the parameters identified from the user selected text portions. Wilce teaches the XML data format storing the information is used to facilitate generation and negotiation of an agreement/contract document; however, Wilce does not expressly state the data structure represents an ordering of information to be elicited when the workflow is executed or using the data structure as a template to drive the workflow process. Teng discloses accessing an XML template that has been created and that indicates parameters for defining workflows and creating a definition for a workflow based on the XML template which meets the limitation, ***analyzing user-selected text portion of the document to id at least one user-selected process parameter comprises tagging the XML file to include the corresponding user-selected***

workflow process parameters identified from the user selected text portions. See page 1, paragraph [0014], page 14, paragraph [0184], and page 42.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

Regarding claim 41, the prior art disclosure in Zhou teaches **detecting user-selected text portions of a displayed contract document** in a product called ContractMaker. See page 1, paragraph [0004]-[0005]. The prior art disclosure in Zhou teaches analyzing the text portion to identify a parameters for assembling a portion of a contract such as the parties involved in the contract which meets the limitation, ***a software tool usable by a user to specify the order in which tagged information is provided within the workflow process***. See page 1, paragraph [0004]-[0005].

11. Claims 4, 7-9, 29, 30, and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art disclosed in Zhou et al., US 2003/0018481 A1, 01/23/03 (filed 03/15/01) in view of Wilce et al., US 2003/0023527 A1, 01/30/03 (filed 08/14/01) and Teng, US 2002/0152254 A1, 10/17/02 (filed 11/30/01, provisional filed on 12/22/00), and further in view of Dahlin et al., US 2004/0122701 A1, 06/24/04 (filed 11/23/01).

Regarding claim 4, Zhou does not teach the workflow process parameters comprise questions to be asked. However, Dahlin discloses a workflow in which an interface is provided for asking a plurality of questions about a patient in order to arrive at a diagnosis. See abstract, page 4, paragraphs [0041]-[0044] and figures 13-16. Dahlin teaches the interface provides a plurality of questions to be asked or entered about a patient. Entering a question about the patient is creating a question to be asked. See page 2, paragraph [0017] of Dahlin. It would have been obvious to a person of ordinary skill in the art at the time of the invention that a workflow process of Zhou/Wilces/Teng would comprise **questions to be asked** because workflow processes often consist of workflow tasks to be performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Regarding claim 7, Zhou/Wilces/Teng teach the user specifies the parameters that define the workflow process and generating questionnaires based on those

parameters; however, Zhou/Wilces/Teng do not expressly state the questionnaire is a user-selected creation of a question. Dahlin discloses a workflow in which an interface is provided for asking a plurality of questions about a patient in order to arrive at a diagnosis. See abstract, page 4, paragraphs [0041]-[0044] and figures 13-16. Dahlin teaches the interface provides a plurality of questions to be asked or entered about a patient. Entering a question about the patient is ***creating a question to be asked***. See page 2, paragraph [0017] of Dahlin. It would have been obvious to a person of ordinary skill in the art at the time of the invention that a workflow process of Zhou/Wilces/Teng would comprise questions to be asked because workflow processes often consist of workflow tasks to be performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Regarding claim 8, Zhou/Wilces/Teng do not expressly teach detecting user-selected valid responses for a question that will be asked during the workflow process; however Dahlin discloses a medical workflow system in which a GUI is used by a health care professional to answer a set of questions to arrive at a diagnosis. The user selection of a *pre-existing* valid response is ***a user-selected valid response for a question***. See page 4, paragraphs [0041]-[0044] and figures 13-16. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Dahlin's system of valid answers to questions in the system of Zhou/Wilces/Teng because workflow processes often consist of workflow tasks to be

performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Regarding claim 9, Zhou/Wilces/Teng teaches defining a workflow and subflow processes. Teng does not teach the user selects dependencies among questions; however, workflows generally comprise questions that determine the next workflow task as disclosed by Dahlin. Dahlin discloses a workflow in which an interface is provided for asking a plurality of questions about a patient in order to arrive at a diagnosis. See abstract, page 4, paragraphs [0041]-[0044] and figures 13-16. The answer to one workflow question determines the next question which meets the limitation ***detecting user-selected dependencies among questions***. These are termed "prerequisite questions". See page 9, paragraph [0080]. It would have been obvious to a person of ordinary skill in the art at the time of the invention that a workflow process of Zhou/Wilces/Teng would comprise questions with dependencies to be asked because workflow processes often consist of workflow tasks to be performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Regarding claim 29, while Zhou/Wilces/Teng teach generating a questionnaire, they do not teach generating computer displays partitioned into distinct phases comprised of steps where the steps comprise questions. However, Dahlin teaches prompting a user to solicit information regarding patient conditions and presenting a diagnosis of the patient based on the responses. See figures 13-16, page 4,

paragraphs [0041]-[0044]. Dahlin teaches displaying medical diagnostic and treatment information to the user based on the health professional's choices throughout the workflow process represented by phases, steps, and questions which meets the limitation, ***the computer displays are partitioned into distinct phases comprised of steps, wherein each step comprises at least one question***. See pages 2, paragraph [0017]-page 3, paragraph [0026].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Dahlin in Zhou/Wilces/Teng's system because workflow processes often consist of workflow tasks to be performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Regarding claim 30, while Zhou/Wilces/Teng teach generating a questionnaire, they do not teach generating computer displays partitioned into distinct phases comprised of steps where the steps comprise questions. However, Dahlin teaches prompting a user to solicit information regarding patient conditions and presenting a diagnosis of the patient based on the responses. See figures 13-16, page 4, paragraphs [0041]-[0044]. Dahlin teaches displaying medical diagnostic and treatment information to the user based on the health professional's choices throughout the workflow process comprises distinct steps which meets the limitation, ***generating a computer screen for each of the plurality of distinct steps in the workflow process***. See pages 2, paragraph [0017]-page 3, paragraph [0026].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Dahlin in Zhou/Wilces/Teng's system because workflow processes often consist of workflow tasks to be performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Regarding claim 32, Teng does not teach generating computer displays partitioned into distinct phases comprised of steps where the steps comprise questions. However, Dahlin teaches prompting a user to solicit information regarding patient conditions and presenting a diagnosis of the patient based on the responses. See figures 13-16, page 4, paragraphs [0041]-[0044]. Dahlin teaches displaying medical diagnostic and treatment information to the user based on the health professional's choices throughout the workflow process which meets the limitation, ***the computer displays are arranged into phases, steps, and questions ordered into a sequence determined by a plurality of user-selected workflow parameters***. See pages 2, paragraph [0017]-page 3, paragraph [0026]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the teachings of Dahlin in Teng's system because workflow processes often consist of workflow tasks to be performed and often require questions related to a condition to be asked in order to execute the next task and properly diagnose a problem. See pages 1-2 of Dahlin.

Response to Arguments

13. Applicant's arguments and amendments filed 01/07/09 have been fully considered.

On pages 9-11, Applicant argues claims 1, 20, 27, 31, and 33 are not taught by the prior art references because Zhou does not teach tagging the document to correlate each user-selected portion with a user-selected order within the workflow process.

Upon further review, Examiner finds Teng teaches tagging a document to correlate user-selected portions with an order within the workflow process. Specifically, Teng discloses workflow templates where workflow objects and actions can be defined. These templates can be in XML format. XML formatted templates contain tags. See page 1, paragraph [0014], page 14, paragraph [0184], and page 42. See also page 15, page 18, paragraphs [0220]-[0221]. Therefore, Teng discloses tagging a document to correlate a text portion of a document with an order in the workflow.

On page 10, Applicant argues Teng does not teach phases, steps, and questions as recited in claims 2-4. Applicant states that although the workflow of Teng is analogous to the phases or steps, it does not teach both.

Examiner disagrees.

Teng teaches the workflow attributes and parameters defined in the template define the **steps** of a workflow process. The steps of workflow process are a part of a phase. The template is an XML document that defines a set of parameters for each of the actions available to that particular workflow type. See page 14, paragraph [0184]

and page 15. Actions of the workflow are executed in the order they appear. The prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract. See page 1, paragraphs [0004]-[0005].

On page 10, Applicant argues Zhou does not teach that the user-selected workflow process parameters disclose questions to be asked as claimed in claim 4. Applicant's arguments with respect to claim 4 has been considered but are moot in view of the new ground(s) of rejection including Dahlin.

On pages 10-11, Applicant argues Zhou fails to teach detecting user-selected modification of a label used to designate a phase as recited in claim 6. Applicant's arguments with respect to claim 6 has been considered. Zhou does not teach detecting a user-selected modification of a label used to designate a phase. Teng discloses a user can select the identification or unique name to identify a workflow. See page 15, paragraph [0189]. Further, Teng teaches each phase has a name. See page 17, paragraph [0211]. This indication of the name of a step in the workflow meets the limitation, **detecting a user-selected modification of a label used to designate a phase**. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have incorporated Teng's XML template representing an ordering of information to be elicited when a workflow process is executed in the contract/negotiation document systems disclosed by Zhou/Wilce because the use of XML to drive a workflow process provides for flexibility and a technology neutral

exchange of information. See page 1 of Zhou and page 6, paragraphs [0086]-[0087] of Wilces. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to use the XML template to facilitate the contract negotiation workflow of Zhou/Wilce. Using the **known technique of an XML template to facilitate a workflow** as taught by Zhou in the contract negotiation workflow process of Zhou/Wilce would have been obvious to one of ordinary skill.

On page 11, Applicant argues Zhou does not teach generating computer displays that are arranged into phases containing steps, wherein the steps comprise one or more questions as claimed in claim 15.

Examiner disagrees.

The prior art of Zhou discloses the user selected parameters are used to generate a questionnaire to be asked during the workflow process creating a contract and that a user can edit that contract thus changing the questions that are asked during the creation of a contract. See page 1, paragraphs [0004]-[0005]. This meets the limitation, ***generating computer displays that are arranged into phases containing steps, wherein the steps comprise one or more questions.***

On page 10, Applicant argues Zhou does not teach reverse engineering, tagging, or superimposing editing tools over a contract document as recited in claim 20,

Examiner disagrees.

Zhou in combination with Wilce and Teng teaches reverse engineering a document. Specifically, Zhou discloses analyzing portions of a contract to determine parties involved and other information in paragraphs [0004]-[0005] discussing

ContractMaker. Further, in response to applicant's arguments, the recitation "reverse engineering" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). With respect to the tagging feature, Teng is relied upon to teach tagging. Regarding the superimposed editing tool, the prior art disclosure in Zhou displaying a contract document on an interface and receiving user input from the user interface to provide information regarding the contract which meets the limitation, ***receiving user input from editing tools superimposed over the contract text document***. See page 1, paragraph [0004]-[0005].

On pages 10-11, Applicant argues Dahlin is not relevant to the prior art. Applicant further argues Dahlin does not teach detecting user selected valid responses for a question that will be asked during the workflow process and only suggests detecting answers to questions.

Examiner disagrees.

Both Dahlin and the prior art deal with workflow processes. Workflow processes can be implemented in various systems from contract negotiations to physician workflows. Therefore, Dahlin is relevant to the claimed invention and the other cited references in that it deals with workflow processes.

With respect to claim 8, Applicant argues Dahlin does not teach user-selected valid responses for a question. Applicant argues at best, Dahlin describes pre-existing valid responses from which a user must choose. Examiner respectfully disagrees with Applicant's rationale. The user selection of a *pre-existing* valid response is still a user-selected valid response for a question. See page 4, paragraphs [0041]-[0044] and figures 13-16 of Dahlin.

It is noted that claim 19 is now rejected under 35 USC 101 but is not rejected under prior art.

In view of the comments above, the rejections are maintained.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHNA S. DESAI whose telephone number is (571)272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Rachna S Desai/
Primary Examiner, Art Unit 2176
03/26/09